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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,895	04/18/2001	John B. Costello	D.N.7152	8364

7590 12/21/2005  
PAUL M. DENK  
763 South New Ballas Rd.  
St. Louis, MO 63141

EXAMINER

NAJARIAN, LENA

ART UNIT PAPER NUMBER

3626

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/837,895

Applicant(s)

COSTELLO, JOHN B.

Examiner

Lena Najarian

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20051003.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 10/3/05.

Claims 1-10 remain pending. Claims 1-5, 7, and 9-10 have been amended.

### ***Specification***

2. The objection to the abstract is hereby withdrawn due to the amendment filed 10/3/05.

### ***Claim Objections***

3. Claim 5 is objected to because of the following informalities: at line 5 there is a typographical error. The removal of "=" is requested. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The rejection of claims 2-7 and 9-10 under 35 U.S.C. 112, second paragraph, is hereby withdrawn due to the amendment filed 10/3/05.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

Art Unit: 3626

be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crane (5,748,907) in view of Feinberg (6,082,776).

(A) Claim 1 has been amended to now recite an integrated "single page" medical patient's record.

Crane does not expressly disclose a single page.

Feinberg discloses a one page personal medical history (Fig. 4 and col. 4, lines 34-39 of Feinberg).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Feinberg within Crane. The motivation for doing so would have been to quickly provide vital medical history information (col. 4, lines 54-55 of Feinberg).

The remainder of claim 1 is rejected for the same reasons given in the previous Office Action, and incorporated herein.

(B) The amendments to claims 2, 3, 4, 5, 9, and 10 were apparently made to overcome 112, 2<sup>nd</sup> paragraph issues set forth in the prior Office Action and/or to re-arrange the order of claim elements so that the language of the claim is smoother and more consistent. However, these changes do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action. As such, these claims are rejected under the same rationale given in the prior Office Action, and incorporated herein.

Art Unit: 3626

(C) Claims 6 and 8 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

(D) Claim 7 has been amended to now recite an integrated "single page" medical record.

Crane does not expressly disclose a single page.

Feinberg discloses a one page personal medical history (Fig. 4 and col. 4, lines 34-39 of Feinberg).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Feinberg within Crane. The motivation for doing so would have been to quickly provide vital medical history information (col. 4, lines 54-55 of Feinberg).

Claim 7 includes additional amendments that were apparently made to overcome 112, 2<sup>nd</sup> paragraph issues set forth in the prior Office Action. However, these changes do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same rationale given in the prior Office Action, and incorporated herein.

The remainder of claim 7 is rejected for the same reasons given in the previous Office Action, and incorporated herein.

### ***Response to Arguments***

Art Unit: 3626

7. Applicant's arguments with respect to claims 1 and 7 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments filed 10/3/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 10/3/05.

(1) Applicant argues from pages 10-14 that the Crane reference includes features not present in Applicant's invention. For example, Applicant states the following:

Unlike in Crane, the present invention does not have a room.

The present invention does not check appointments against demand for them or facilities.

The present invention does not sense inputs but rather has the doctor enter codes himself upon the single page digital form.

The present invention does not rely upon simulations to prove its management of information collected in an examination room.

The present invention does not have rooms but rather a digital single page form with sections for a doctor to complete during an examination.

The present invention does not address management reports for a medical facility.

The present invention does not rely upon a coordinator.

(2) Applicant argues that collecting and organizing medical, demographic, and financial information upon a single page digital form is not obvious given the number of functions and data for a typical medical visit.

Art Unit: 3626

(3) At pages 14-15, Applicant argues that a single page record produced by the present invention is not taught by Crane as the number of functions and data streams managed by Crane defies use of a single page. Examiner asserts that conservation of resources, as in paper, would motivate modifying Crane into a single page format. Applicant counters that the costs incurred in re-programming Crane into a single page format would far exceed the savings in paper.

(4) At page 15, Applicant argues that the present invention transmits information through a network while Crane uses a link. A network implies a web of communication connections while a link implies a single connection.

(5) At page 16, Applicant argues that the present invention provides an address of any outside provider utilized during or following a patient examination.

(6) At page 16, Applicant argues that regarding claim 6, SAVE implies information is kept while DONE of Crane implies a session is completed and has no reference to information keeping.

(7) At page 17, Applicant argues that Crane does not show the diagnosis on the visit summary as done by the present invention.

(8) At page 18, Applicant argues that Crane does not teach of the information collected by the doctor flowing into other systems to request further services and to generate a bill.

(A) As per the first argument, it is irrelevant whether the applied reference contains elements in addition to or beyond those claimed by Applicant, and not required by Applicant, insofar as Applicant uses the words "comprising" or

Art Unit: 3626

"including" at end of each preamble of the pending claims. The Examiner understands this claim language to mean "having at least". If Applicant desires to claim an invention that is exclusively limited to only those elements specifically recited in the claims, the Examiner suggests that Applicant use the term "consisting of" rather than "comprising" or "including."

(B) As per the second and third arguments: In response to applicant's argument that a single page digital form is not obvious, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, while re-programming Crane may be costly, in the long run, the system would still conserve resources, such as ink and paper by providing a single page format.

(C) As per the fourth argument, the Examiner respectfully submits that Crane discloses the use of a network (see col. 12, lines 45-48 and Fig. 1 of Crane).

(D) As per the fifth argument, the Examiner respectfully submits that Crane stores the locations of providers utilized by patients while traveling (see col. 18, line 63 – col. 19, line 10 of Crane). As such, it is readily apparent that Crane teaches the address of any outside provider utilized.

Art Unit: 3626

(E) As per the sixth argument, the Examiner respectfully submits that Crane teaches storing data accumulated during the patient's visit (col. 34, lines 59-65 of Crane). As such, it is readily apparent that Crane discloses information keeping.

(F) As per the seventh argument, the Examiner respectfully submits that Crane discloses at col. 13, lines 34-38, that the visit summary includes a description for the patient on what was performed and concluded and at col. 23, lines 43-51 discloses test results. As such, it is readily apparent that Crane teaches the diagnosis on the visit summary.

(G) As per the eighth argument, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., information collected by the doctor flowing into other systems to request further services and to generate a bill) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches an apparatus for and method of assessing, monitoring, and reporting on behavioral health disorders (US 2001/0034615 A1); and a method for analyzing the glycation of hemoglobin (5,384,239).

Art Unit: 3626

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is 571-272-7072. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



In

11-29-05

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600